



**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2600**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named

Inventor : Errol C. Heiman et al.

Appln. No.: 09/823,079

Filed : March 30, 2001

For : COMPREHENSIVE APPLICATION POWER
TESTER

Docket No.: S104.12-1022/STL 9524

Group Art Unit: 2161

Examiner:

Etienne Pierre Leroux

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents

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PATENT ATTORNEY

Sir:

Applicant respectfully requests Pre-Appeal Brief Review of the rejections of claim 18 under 35 U.S.C. §112 and §101, since the rejections are based on clear error of fact and omission of essential elements to establish a prima facie rejection.

Also, Applicants respectfully request Pre-Appeal Brief Review of the rejection of claims 18 and 28 under §102(e) and §103(a), since these rejections are also based on clear error of fact and omission of essential elements to establish a prima facie rejection.

A. Applicants' Objection to a Piecemeal Examination Process

Applicants are entitled to a full and complete examination with each Office Action, not a piecemeal examination in which new rejections are made in each Office Action that relate to the wording of unamended claim language, amendments suggested by the Examiner in a prior Office Action, or new references that are irrelevant and not cited in view of any prior claim amendments.

Applicants' representative attempted to discuss the rejections with the Examiner, but he was unwilling and merely responded saying that all he had to say about the case was in the Office Actions. Each Office Action appears to almost randomly select terms/phrases in the claims and suggest that they are unsupported by the specification and/or indefinite. Further, the Examiner has

cited numerous references during the prosecution of this application, most of which are substantially irrelevant, as evidenced, on different occasions, by the citing of new references in a subsequent Office Action even if no claim amendments were made in response to an immediately previous Office Action.

B. Claim Arguments

I. CLAIM REJECTIONS UNDER 35 U.S.C. §112

On page 2 of the Office Action, claim 18 was rejected under 35 U.S.C. §112, first paragraph. Specifically, the Office Action contends that the purpose of “an additional power source,” included in claim 18, is unknown and thus a skilled artisan would not know how to make and use the invention.

The apparatus shown in FIG. 1 of the Application includes a power control module (PCM) 104 which includes multi-voltage (+5 VDC and +12 VDC) power source 107 and additional power source 108. These two power sources are described in the Specification on page 4. Additionally, page 4 of the Specification describes a variable low disturbance switch 109, which is connected to multi-voltage power source 107, and a variable peak disturbance switch 110 that receives its power from additional power source 108. Since one purpose of additional power source 108 is to provide variable peak disturbance switch 109 its power, Applicants had possession of the invention of claim 18 at the time of filing and such invention is disclosed in the Specification.

On page 3 of the Office Action, claim 18 was rejected under 35 U.S.C. §112, second paragraph. Specifically, the Office Action first contends that it is unclear whether an “an additional voltage level” and “a plurality of voltage levels” are actually functioning as a part of the invention. Further, the Office Action suggests that it is difficult to determine the metes and bounds of the claim limitation of “an additional voltage level that is different from the plurality of selectable voltage levels” because it unclear as to exactly what comprises “different from the plurality of selectable voltage levels.” Also, the Office Action states that it is unclear as to exactly what comprises “a second voltage output” and exactly what comprises “an additional voltage level.”

In an Amendment that was filed on October 2, 2006, claim 18 was re-worded, in response to §112, second paragraph, rejections in an Office Action mailed on July 3, 2006, to positively

recite the various outputs and to distinguish various voltage levels. The above rejections in the instant Office Action make it appear that claim 18 has to be changed back to its original form (prior to being re-worded) in order to be sufficiently definite. Therefore, the §112, second paragraph, rejections in the instant Office Action are somewhat contrary to the §112, second paragraph, rejections in the Office Action mailed on July 3, 2006. In any event, Applicants respectfully submit that claim 18 is sufficiently definite in its current form and respectfully request that the improper contradictory §112, second paragraph, rejections be withdrawn.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §101

On page 4 of the Office Action, claims 18 was rejected under 35 U.S.C. §101 as being unsupported by either an asserted utility or a well established utility.

The United States Patent and Trademark Office issued Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (the Guidelines) in the Official Gazette Notice of November 22, 2005. In the Guidelines, it is stated that:

"To satisfy §101 requirements, the claim must be a practical application of the §101 judicial exception, which can be identified in various ways:

- The claimed invention "transforms" an article or physical object to a different state or a thing.
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below." (The Guidelines § IV, C, 2).

The definition of a useful, concrete and tangible result is found in the guidelines. For a result to be "useful" it must satisfy the utility requirement of §101. The United States Patent and Trademark Office's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial, and (iii) credible. (The Guidelines § IV, C, 2, b (1)). A result is "concrete" if it can be assured. "In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same results again." (The Guidelines § IV, C, 2, b, (3)). A result is "tangible" if it produces "a real world result." (Interim Guidelines § IV, C, 2, b (2)). (Emphasis Added.)

Applicants respectfully point out that claim 18, which is directed to a power tester, is an apparatus claim. In an apparent attempt to classify this claim as a process claim, and thereby apply the above §101 requirements, the Examiner incorrectly states that the preamble claims a “power test.” After this incorrect statement, several additional statements alleging a lack of clarity of individual elements of claim 18 are included in the §101 rejection. Applicants respectfully point out that these statements are misplaced and lack any relevance in connection with the presence or absence of utility in apparatus claim 18. Therefore, the rejection should be withdrawn. In any case, the apparatus recited in claim 18 clearly has voltage outputs that can be used to test one or more electronic devices and therefore has undeniable utility.

III. CLAIM REJECTIONS UNDER 35 U.S.C. §102

On page 4 of the Office Action, claims 18-20, 24-30 and 34-36 were rejected under 35 U.S.C. §102(e) as being anticipated by Ehiro, U.S. Patent No. 5,970,074.

Claim 18, which is directed to a power tester, requires “a multi-voltage power source having a first voltage output, which is capable of supplying a plurality of selectable voltage levels for a constant power supply voltage at a nominal power supply voltage of an electronic device,” and “an additional power source having a second voltage output, which is capable of supplying an additional voltage level that is different from the plurality of selectable voltage levels.”

Nothing in Ehiro teaches the above elements of claim 18. The only power source in Ehiro is power source 10 that is shown in FIG. 1, which is the only figure in Ehiro that shows an apparatus. The cited figures (FIGS. 4 and 5) and language (column 7, lines 10-50), which show and describe different waveforms, teach nothing about “a multi-voltage power source having a first voltage output, which is capable of supplying a plurality of selectable voltage levels for a constant power supply voltage at a nominal power supply voltage of an electronic device,” and “an additional power source having a second voltage output, which is capable of supplying an additional voltage level that is different from the plurality of selectable voltage levels,” required by claim 18. Thus, Ehiro does not anticipate claim 18.

Independent claim 28 has limitations similar to that of independent claim 18. Thus, for the same reasons as independent claim 18, Applicants submit that independent claim 28 is allowable as

well. Moreover, Applicants respectfully submit that the dependent claims rejected under 35 U.S.C. §102 are also allowable at least by virtue of their dependency either directly or indirectly from the allowable independent claims. Further, the dependent claims set forth numerous elements not shown in Ehiro.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. §103

On page 6 of the Office Action, claims 21 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ehiro in view of Cronvich et al., U.S. Patent No. 5,386,183. Also, claims 23 and 33 were rejected under §103(a) as being unpatentable over Ehiro in view of Lee et al, U.S. Patent No. 4,764,652.

Claims 21 and 23 ultimately depend from independent claim 18, and claims 31 and 33 ultimately depend from independent claim 28. As noted above, Ehiro shows only one power source and therefore does not teach the elements of claims 18 and 28. Further, Ehiro suggests nothing about "a multi-voltage power source having a first voltage output, which is capable of supplying a plurality of selectable voltage levels for a constant power supply voltage at a nominal power supply voltage of an electronic device," and "an additional power source having a second voltage output, which is capable of supplying an additional voltage level that is different from the plurality of selectable voltage levels." Cronvich and Lee do not overcome the deficiencies of Ehiro. Thus, claims 21, 23, 31 and 33 are allowable over the cited art (Ehiro, Cronvich and Lee).

In view of the foregoing, Applicants respectfully request reconsideration and allowance of claims 18-21, 23-31 and 33-36. Favorable action upon all claims is solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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